



Attorney's Docket No. 028670-080

Patent

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In re Patent Application of )  
)  
Sean Lee et al. )  
)  
Application No.: 09/012,272 )  
)  
Filed: January 23, 1998 ) Group Art Unit: 1616  
)  
For: Bioactive Glass Treatment of ) Examiner: J. PAK  
Inflammation in Skin Conditions )

RESPONSE

Assistant Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Sir:

In complete response to the Examiner's Official Action of September 13, 2001, Applicants provide the following information to obviate the remaining rejections. Claims 1-4, 6 and 8-9 are pending in the application. A terminal disclaimer is attached hereto.

Claims 1-4, 6 and 8-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Greenspan et al., U.S. Patent No. 5,834,008 in view of Litkowski et al., U.S. Patent No. 6,086,374. Applicants respectfully traverse this rejection.

U.S. Patent No. 5,834,008 issued November 10, 1998. The present application was filed February 23, 1998. Since the '008 patent issued after the filing date of the present application, the '008 patent can only be prior art under 35 U.S.C. § 102(e) (the other sections do not apply). However, according to 35 U.S.C. § 103(c), "subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 35 U.S.C. § 102(b) of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

This section of the patent statute applies to all applications filed after November 29, 1999. *P.L. 106-113 § 4807(b)*. In the present case, a continued prosecution application under 37 C.F.R. § 1.53(d) was filed January 19, 2000, after the effective date of the statute. Thus, the statute applies to this application. **The '008 patent and the present application were, at the**

time the invention of the present application was made, owned by the same entity, U.S. **Biomaterials Corp.** Thus, the patentability of the present invention is not precluded by the '008 patent. In view thereof, Applicants respectfully request that this rejection be withdrawn.

Claims 1-4, 6 and 8-9 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-11 of the '008 patent in view of Litkowski et al. Although Applicants believe the present claims are patentable over claims 10-11 of the '008 patent, in order to expedite prosecution of the application, Applicants respectfully submit the enclosed terminal disclaimer. In view thereof, Applicants respectfully request that this rejection be withdrawn.

Applicants believe they have responded to all matters raised in the above referenced Office Action and that the application is now in condition for allowance. If the Examiner has any questions concerning this Application or this Reply and Amendment, he is invited to contact the undersigned.

Respectfully submitted,

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